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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/203,672	02/28/1994	BRIAN H. SILVER	5297/32	1958

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EXAMINER

TRINH, HOA B

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/203,672

Applicant(s)

SILVER ET AL.

Examiner

Vikki H Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 8-14 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-11 and 19 is/are allowed.
- 6) ☒ Claim(s) 6 and 12-13 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Response to Arguments

In view of the Appeal Brief filed on 09/27/01, PROSECUTION IS HEREBY REOPENED. Response to this Office Action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

An anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

It is well settled that the law of anticipation does not require that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claims are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. See, for example, *Standard Havens Products Inc. v. Gencor Industries Inc.*, 953 F.2d 1360, 21 USPQ2d 1321 (Fed. Cir. 1991).

2. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Yanase (4634006).

Yanase (4634006) discloses a bag 70, 1 for breastmilk. The bag has a front side 7, 15 and a back side 8, 16 and being initially empty of contents and hermetically sealed about a portion 75, 76, 77, 78, 79, 2, 3 for receiving breastmilk therein, an opening being defined in the bag. The opening being initially closed by a releasable seam means 5 between the front and back sides. See figures 1 and 25, the abstract, and columns 1-10.

The examiner notes the following meaning of the words below from Merriam-Webster Dictionary.

The word "seam" is defined as follows:

1. the joining of two pieces (as of cloth or leather) by sewing usually near the edge b : the stitching used in such a joining
2. a line, groove, or ridge formed by the abutment of edges .

The word "releasable" is defined as follows":

1. to set free from restraint, confinement
3. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Van Erden et al. (4786190).

Van Erden et al. (4786190) discloses a bag 20 for storing contents. The bag has a front side 21 and a back side 21 and being initially empty of contents and hermetically sealed about a portion 24 for receiving content therein, an opening 25 being defined in the bag. The opening being initially closed by a releasable seam means 27 between the front and back sides. See figure 1, the abstract, and columns 1-4.

The examiner notes that the contents in the bag may be breastmilk.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanase (4634006) in view of Graham (3905477).

Yanase (4634006) discloses the invention substantially as claimed. Yanase (4634006) discloses a bag 70, 1 for breastmilk. The bag has a front side 7, 15 and a back side 8, 16 and being initially empty of contents and hermetically sealed about a first seal line portion 75, 76, 77, 78, 79, 2, 3, 5 for receiving breastmilk therein, an opening being defined in the bag. The opening being initially closed by a second seal line 5 between the front and back sides. The bag includes a pour spout 83 with a notch 82. See figures 1 and 25, the abstract, and columns 1-10. However, Yanase does not explicitly teach a writing area integral to the bag by the first seal.

Graham (3905477) discloses a bag 11 having a seal 19, a front side 15 and a back side 27, and a writing area 23 integrally connected to the bag by the seal. See figure 1.

Yanase and Graham are analogous art, because they are in the same field of endeavors.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Yanase with a writing area integral to the first seal 77, 5 as taught by Graham, for identifying the contents inside the bag.

The courts have concluded that there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). Also, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

Allowable Subject Matter

Claims 8-11, 19 are allowed.

The prior art of record does not disclose nor fair suggest either singular or in combination a pour spout formed integral with the bag by the hermetically seal along the writing area, wherein said pour spout includes an inboard part defining a stop when the pour spout is opened.

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not disclose a combination of a tie and two holes for closing the bag and removing from the breast pump.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hughes (2991001) discloses a resalable container bag. See entire document.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vikki H Trinh whose telephone number is 703-308-8238. The examiner can normally be reached on Mon.-Tues, Thurs.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 703-306-2794. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Vikki Trinh
November 17, 2001



Olik Chaudhuri
Supervisory Patent Examiner
Technology Sector 2800